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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,550

11/14/2003

William E. Sobel

SYMAP037

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35833 7590 02/22/2008

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EXAMINER

POWERS, WILLIAM S

ART UNIT

PAPER NUMBER

2134

MAIL DATE

DELIVERY MODE

02/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/714,550	Applicant(s) SOBEL ET AL.	
	Examiner WILLIAM S. POWERS	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/5/2007 have been fully considered but they are not persuasive.
2. The added limitation, "providing access to at least the file and configuration setting in a virtual environment" (claim 1, lines 9-10) is addressed below.
3. As to Applicant's argument that, "Replacing an image with a new image, as taught by Steele, is not the same as manipulating data comprising an image to eliminate the vulnerability in the image itself" (Remarks, page 4, lines 15-16), the Examiner respectfully disagrees. The Examiner has addressed this issue on page 2, paragraph 5 in the previous Office Action. Steele's process changes only those components of an image that require patching and/or upgrading. As a result the image is changed. One of ordinary skill in the art would recognize that any change to a computer file results in a different computer file. If the computer file before the change is compared to the computer file after the change the computer considers the two files to be different. It appears that the Applicant is arguing that "manipulating" data of the instant invention does not result in changes to the image. For at least the reasons above, the rejection of the claims is maintained.

Response to Amendment

4. The Examiner has stated the below column and line numbers as examples. All columns and line numbers in the reference and the figures are relevant material and Applicant should be taken the entire reference into consideration upon the reply to this Office Action.
5. Claim 1 has been amended.
6. Claims 1-4 are pending.

Information Disclosure Statement

7. No Information Disclosure Statements have been submitted with the application.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner can find no support in the specification for the negative limitation, "as opposed to by eliminating the vulnerability in a source system with which the image is associated and then creating from the source system a replacement image that does not have the vulnerability". Specifically, there is no mention of a "source system with which the image is associated" or a "source system" in the specification. "The mere absence of a positive recitation is not basis for an exclusion" (MPEP, 2173.05(i)). For at least the reasons above, the aforementioned amendment to claim 1 is considered new matter.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear from the claim language or the specification what comprises "the source system" of the amended claim. For purposes of examination, the Examiner assumes that "the source system" refers to the computer system that runs and stores the image.

Claim Rejections - 35 USC § 103

Art Unit: 2134

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application No. 2003/0212716 to Steele et al. (hereinafter Steele) in view of US Patent No. 5,696,822 to Nachenberg.

As to claim 1 as best understood, Steele teaches:

- a. Providing access to the image to allow the configuration setting to be manipulated (analyzing the backup images) (Steele, paragraphs 59-60).
- b. Identifying the vulnerability in the image (scanning for viruses to ensure the integrity of the backup images) (Steele, paragraphs 59-60).
- c. Eliminating the vulnerability in the image by manipulating the configuration setting or file (applying updates and fixes to the backup images and generating an audit trail to document the changes to the backup images) (Steele, paragraphs 59-60).

Steele does teach isolating images during analysis so as not to degrade system performance (Steele, paragraph 8), but does not expressly mention using a virtual environment. However, in an analogous art, Nachenberg teaches:

- d. Wherein providing access to the image to allow the configuration setting to be manipulated includes providing access to at least the file and the configuration setting in a virtual environment (Nachenberg, col. 5, lines 32-40).

Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to implement the virus scanning of Steele with the virtual environment of Nachenberg in order to “isolate potentially infected files from the actual CPU and memory” as suggested by Nachenberg (Nachenberg, col. 5, lines 32-40).

Steele further teaches:

- e. In a manner that allows the configuration setting to be changed by modifying a portion of the image that is associated with a configuration database in which the

configuration setting is stored with the result that the vulnerability is eliminated from the image by manipulation of data comprising the image itself (the components (portions) of the master image that are subject to upgrades and/or bug fixes are modified creating a new master image) (Steele, paragraph 60).

f. As opposed to by eliminating the vulnerability in a source system with which the image is associated and then creating from the source system a replacement image that does not have the vulnerability (Steele only modifies the image that presents a vulnerability) (Steele, paragraphs 59-61).

As to claim 2, Steele as modified teaches providing access to the file and the configuration setting (applying updates and fixes to the backup images and generating an audit trail to document the changes to the backup images) (Steele, paragraphs 59-60).

As to claim 3, Steele as modified teaches updating the configuration setting (applying updates and fixes to the backup images and generating an audit trail to document the changes to the backup images) (Steele, paragraphs 59-60).

As to claim 4, Steele as modified teaches modifying the file (Steele, paragraphs 59-60).

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM S. POWERS whose telephone number is (571)272-8573. The examiner can normally be reached on m-f 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571 272 3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. S. P./

Examiner, Art Unit 2134

William S. Powers
Examiner
Art Unit 2134

2/15/200

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2132